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Paper No. 44

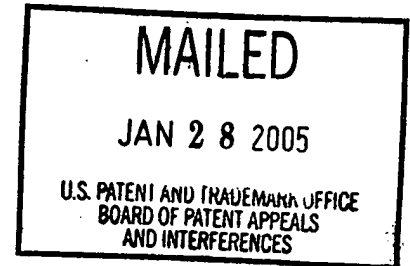
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUIS J. RODRIGUEZ

Appeal No. 2005-0041
Application 09/978,215

ON BRIEF



Before KIMLIN, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.
PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 45-59 and 61-70.¹ A copy of each of these claims is set forth in the attached Appendix.

As indicated in the supplemental examiner's answer of Paper No. 40, the following rejections are pending (see pages 2-3 of the supplemental examiner's answer):

Claims 45-49 and 68-70 stand rejected under 35 U.S.C. § 112, first paragraph (written description support).

Claims 45-47, 62-64, and 66 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schieman.

¹ We note that claim 60 was finally rejected, but is not under appeal. Brief, page 1.

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Claims 45-47, 49-51, 53-55, 57, 58, 62-64, 66, and 67 stand rejected under 35 U.S.C. § 103 as being obvious over Johnson in view of Wilbur or Schieman.

Claims 48, 52, 56, and 65 stand rejected under 35 U.S.C. § 103 as being obvious over Johnson in view of Wilbur or Schieman, and further in view of Stenner.

Claims 59 and 61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Johnson in view of Wilbur or Schieman.

Appellant groups the claims as set forth on page 10 of the brief. We consider those claims which the appellants have contested with reasonable specificity. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

The examiner relies upon the following references as evidence of patentability:

Schieman	2,367,440	Jan. 16, 1945
Wilbur	2,384,223	Sep. 04, 1945
Johnson	3,027,067	Mar. 27, 1962
Stenner	5,607,100	Mar. 04, 1997

OPINION

I. Preliminary Matters

As an initial matter, we review the prosecution history, which is summarized below.

The first Office Action was mailed on March 11, 2002 (Paper No 4). In response to this Office Action of Paper No. 4, appellant conducted an interview and, thereafter, filed Amendment A on May 20, 2002 (Paper No. 6). The amendment included changes to the specification and a request to cancel all claims and to substitute them with new claims 23-44. In a response to the amendment, the examiner issued a final rejection that was mailed on June 20, 2002 (Paper No. 8). In this final Office Action, the examiner objected

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to the amendment filed on May 20, 2002 (Amendment A), indicating that the added material to the specification was new matter (the incorporation by reference of Application No. 09/130,534). The examiner rejected claims 23-44 in this final office action. Subsequent to the mailing of this final office action, appellant conducted another interview on June 28, 2002 (Paper No. 9). Appellant then filed a Request for Continued Examination (RCE) on Aug. 23, 2002 (Paper No. 10). This filing included an Amendment B which included a substitute specification and a request to cancel all the claims of record, and the addition of new claims 45-70.

Subsequent to the filing of the above-mentioned RCE with Amendment B, the examiner issued a final rejection mailed September 11, 2002 (Paper No. 12). In this final rejection, the examiner refused to enter the substitute specification, and rejected claims 45-70. We note that it is these claims, as set forth in the Amendment B of Paper No. 11 (claims 45-70), that are at issue in this appeal (i.e., these claims are the same claims as set forth in appellant's Appendix to the brief, with the exception that claim 60 is not under appeal).

In response to the final rejection of Paper No. 12, appellant filed Amendment C, on October 17, 2002 (Paper No. 13). Appellant also filed a petition to admit a model (Exhibit A). Subsequently, the examiner filed an Advisory Action on October 25, 2003 (Paper No. 15), indicating that the proposed amendment (Amendment C) will not be entered and that the Exhibit A will not be considered because it is not directed solely to issues which were newly raised by the examiner in the final rejection.

Subsequently, appellant conducted another interview on October 29, 2002 (Paper No. 16). In this interview, appellant argued that there was no new matter in the un-entered substitute specification or the claims and that the amendment after final (Amendment C) should have been entered.

On January 9, 2003, appellant filed a Petition to the

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Commissioner and also filed a Notice of Appeal. An appeal brief was filed on March 7, 2003 (Paper No. 22). Several papers concerning the Petition, and Decision on Petition, were filed (Paper No. 21, and Paper Nos. 23-33).

An examiner's answer was filed on August 27, 2003 (Paper No. 35). Subsequently, appellant filed a Reply Brief on September 8, 2003 (Paper No. 36). The appeal was remanded to the examiner on June 29, 2004 (Paper No. 39). In the Remand to the examiner, the Board indicated that the Decision on Petition filed on June 2, 2003 stated that arguments "that applied to the claims and to exhibits and attachments of record in the application prior to the final rejection will be considered to be of record."

The Decision on Petition filed on June 2, 2003 also indicated that the amended claims filed in Amendment C (the amendment filed on November 17, 2002, Paper No. 13) are not of record. See page 1 of the Decision on Petition. Therefore, with respect to Amendment C, the examiner was instructed, by the Decision on Petition, to consider arguments presented in Amendment C pertaining to the application of prior art that applied to the claims and exhibits and attachments of record in the application prior to the final rejection, as these items are considered of record and available for consideration on appeal.

We note that the Decision on Petition of June 2, 2003 indicated that the Advisory Action dated October 25, 2002 refused entry of the amendments of Amendment C, and that this refusal extends not only to the amendments but to any and all exhibits and attachments that were not previously submitted in the record prior to the filing of Amendment C. See fourth full paragraph on page 2 of the Decision on Petition.

Our review of Amendment B, filed on August 23, 2002 (Paper No. 11) shows that on page 15, attachments 11A, 11B, 12, 13 and 14 were submitted with Amendment B. Any arguments relating to these attachments that were presented in Amendment C are therefore deemed

part of the record. Any arguments related to any other attachments or exhibits are deemed as not part of the record, and in fact, as indicated, supra, the exhibits and attachments provided with Amendment C have not been entered according to the Advisory Action of Paper No. 15, mailed October 25, 2002, and according to the Decision on Petition of June 2, 2003. The Decision on Petition also indicates that none of the substitute specifications have been entered. In this context, we therefore review the supplemental examiner's answer of Paper No. 40, mailed July 20, 2004.

The examiner is correct in his response as set forth on pages 5-13 of the supplemental examiner's answer, wherein the examiner does not indicate review of any of the exhibits or amendments or attachments to Amendment C.² As indicated above, the examiner is to consider any arguments set forth in Amendment C that pertain to the status of the claims as set forth in Amendment B of Paper No. 11, filed on August 23, 2002, as this is the status of the claims before the final Office Action. The examiner has correctly done so by identifying particular pages of Amendment C that have been considered by the examiner in the supplemental examiner's answer. The examiner has also correctly explained that no new ground of rejection was raised in the examiner's answer (see page 13 of the supplemental examiner's answer).

II. The rejection of claims 45-49 and 68-70 under 35 U.S.C § 112, first paragraph (written description requirement)

On page 4 of the supplemental examiner's answer, the examiner refers to the Office Action of Paper No. 12 regarding this rejection. Beginning on page 2 of the Office Action of Paper No. 12, the examiner's position is that there is no original disclosure

² We therefore disagree with any of appellant's arguments (whether in the brief, reply brief, or supplemental brief) alleging that the examiner incorrectly did not consider such exhibits/amendments/attachments to Amendment C.

for the phrase "mono-sectional body", and also for the phrase "at least one" mono-sectional body.

We refer to the case of In re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983), wherein the examiner concluded that the claim as amended was not disclosed in the specification and that the claims were therefore drawn to new matter. The Federal Circuit affirmed, quoting the Board's statement of the law with approval:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at the time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

Id. at 1375, 217 USPQ at 1096. See also, In re Wetheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); In re Ruschig, 379 F.2d 990, 996, 154 USPQ 118, 123 (CCPA 1967).

As stated above, the examiner rejects claim 45 with regard to the claimed phrase "mono-sectional body" and the claimed phrase "at least one" mono-sectional body. We consider here, therefore, the issue of whether the disclosure of the application, as originally filed, reasonably conveys to the artisan that the inventor had possession, at that time, of this later claimed subject matter.

The examiner states that appellant's remarks in Amendment C found on pages 34-36 are directed solely to the language "mono-sectional body", and do not address the phrase "at least one." The examiner concludes therefore, that with regard to the rejection of claim 45, and its dependent claims 46-49, appellant's arguments are unpersuasive. Answer, page 5.

With regard to the claimed phrase "mono-sectional body," on page 9 of the appeal brief filed on March 7, 2003 (Paper No. 22), appellant argues that the word "body" of the self sealing letter

sheet is the one-ply, unfolded letter sheet itself excluding the flaps. Appellant refers to Exhibit A and page 39 of Amendment C.³

We note that it is a long-standing legal principle that, during examination proceedings, claims are to be given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Hence, our review begins with appellant's specification.

We refer to the first embodiment, as an example. The first embodiment is described, beginning on page 12 of appellant's specification. It involves Figures 7A through Figure 7F. Cut sheet 207 has score lines 208, 210, and 212 separating the body 214 from the flaps 216, 218 and 220, respectively. As shown in Figure 7A, body 214 is depicted. In this manner, we interpret the word "body." One skilled in the art can interpret body 214 as having more than one section, each along score lines 222 and 224, as the specification does not indicate otherwise. Also, Figure 7E shows how each section is folded along the score lines. Hence, we agree with the examiner's position as set forth on page 2 of the Office Action of Paper No. 12, with regard to the claimed phrase "mono-sectional body", i.e., that no support exists for a "mono-sectional body" because body 214 is shown to have more than one section, as discussed herein. The Model of Exhibit A does not alter our determinations herein.

With regard to the modifier "at least one", with respect to the claimed phrase "at least one mono-sectional body", the examiner

³ On page 9 of the brief, appellant asserts that Exhibit A was presented as a demonstration exhibit during an interview conducted with the examiner on October 29, 2002. However, the record indicates that no demonstration or exhibit was shown (see page 1 of the examiner's interview summary form of Paper No. 16). However, appellant did petition to admit the model, entitled "Model Inside (Exhibit A)" as part of Paper No. 14, which the examiner indicated as entered in the Advisory Action of Paper No. 15, and also indicated that this exhibit did not overcome any rejections (see continuation

states that this modifier "implies that there may be more than one envelope 'body'". Office Action of Paper No. 12, page 2.

On page 12 of the appeal brief, appellant argues that the 13th and 14th embodiments are directed to a two-way self sealing mailer, which has a message panel 264 and a reply mailer 244. Appellant believes this embodiment supports "at least one" mono-sectional body. We are not convinced by such arguments, as appellant overlooks the fact that because there is no support for a "mono-sectional body", there is no support for "at least one" mono-sectional body.

In view of the above, we therefore, affirm the rejection under 35 U.S.C. § 112, first paragraph, of claim 45 and its dependent claims 46-49.

With regard to the 35 U.S.C. § 112, first paragraph, rejection of claims 68-70, on page 3 of Paper No. 12, the examiner states "there is no original disclosure of a letter sheet having one layer of repositionable adhesive and one layer of a dry adhesive."

At the bottom of page 5 of the supplemental examiner's answer, the examiner refers to pages 36-37 of Amendment C, regarding this issue, and states "appellant remarks that the original specification supports the combination of a dry adhesive and a low tack adhesive". The examiner does not agree with this statement. The examiner also states "[n]either appellant's original specification nor arguments explicitly state the 'repositionable adhesive' as is now being claimed to mean, or is the same as, 'low tack adhesive'." Supplemental Answer, page 6.

We find several locations throughout appellant's specification that indicate that "[f]or the temporary connection of the flaps to the body, a low tack adhesive 204 is used, interacting with a facing space that has no layer of any substance." See, e.g., page 13, lines 18-19 of the specification, and page 14, lines 24-26. A reasonable interpretation of this disclosure would be that a low

tack adhesive can be used at a location where a temporary connection is desired, which would include the use of a low tack adhesive in combination with a dry adhesive. This disclosure, therefore, does indicate that a combination of a dry adhesive and a repositionable adhesive (low tack adhesive) can be used.⁴

For the above-mentioned reasons, therefore, we do not agree with the examiner's 35 U.S.C. § 112, first paragraph, rejection of claims 68-70.

In summary, therefore, we affirm the 35 U.S.C. § 112, first paragraph, rejection of claims 45-49. However, we reverse the rejection of claims 68-70 under 35 U.S.C. § 112, first paragraph.

III. The Anticipation Rejection of Claims 45-47, 62-64 and 66

The examiner's position for this rejection is set forth on page 5 of the Office Action of Paper No. 12. The examiner further explains his position on pages 7-8 of the supplemental examiner's answer (as well as in the examiner's answer).

Appellant's position for this rejection is set forth on pages 15-20 of the appeal brief filed on March 7, 2003 (Paper No. 22). Appellant states that the product in Schieman, which is an envelope, cannot anticipate a "self-sealing letter sheet" or "a self-sealing form." To the contrary, the examiner believes that the term "letter sheet" does not define over the product of Schieman. Office Action of Paper No. 12, page 5.

We have carefully reviewed all of appellant's arguments set forth in the brief, the reply brief, and the supplemental brief.

⁴ We find that it is reasonable to conclude that the claimed repositionable adhesive is a low tack adhesive, as argued by appellant (e.g., see page 13 of the reply brief).

None of the arguments convince us that the claimed phrase "self sealing letter sheet" or "self sealing letter form", excludes a sheet that is at some point an "envelope" as shown in Schieman. Before the sheet in Schieman is folded into the envelope shown in Figure 1, it is a sheet just as the sheet shown in appellant's Figure 7A is a sheet before it is folded in the envelope shown in Figure 7F. Hence, we agree with the examiner's rejection.

At the bottom of page 17 of the brief, appellant states that the body of Schieman is "tetra-sectional" and that therefore the body in Schieman is not "mono-sectional" as claimed. In support thereof appellant refers to attachments 11A, 11B and 12 and Exhibit A. We have already made our determinations with regard to the Model set forth in Exhibit A (see page 7 of this decision).

Attachments 11A, 11B and 12 are part of the record, as they were filed with Amendment B (Paper No. 11 filed August 23, 2002), which was before the final office action. These attachments compare Schieman's structure with appellant's claimed structure. However, these attachments do not change the fact that the claimed phrase "self sealing letter sheet" or "self sealing letter form", does not exclude a sheet that is at some point an "envelope" as shown in Schieman. As stated, supra, before the sheet in Schieman is folded into the envelope shown in Figure 1, it is a sheet just as the sheet shown in appellant's Figure 7A is a sheet before it is folded into the envelope shown in Figure 7F. Appellant's do not dispute that Schieman's product is built from one blank of a sheet material. Schieman discloses in column 1 at lines 51-55 that the structure in Schieman has a main body or section 1 and a sealed flap 2. Hence, this disclosure suggests a single main body having a flap. Therefore, we agree with the examiner that main body 1 shown in Schieman is from a single sheet.

In view of the above, we affirm the anticipation rejection of claims 45-47, 62-64 and 66.

IV. The 35 U.S.C. § 103 Rejection of claims 45-47, 49-50, 53-55, 57, 58, 62-64 and 67 as being obvious over of Johnson in view of Wilbur or Schieman

The examiner's position for this rejection is set forth on pages 5-6 of the Office Action of Paper No. 12. The examiner's basic position is that Johnson discloses a form having all claimed features, except for the claimed adhesive inhibitor. The examiner states that flaps 8, 8, and 9 of Johnson contain adhesive and are folded onto panel 4. Office Action of Paper No. 12, page 6. The examiner states it would have been obvious to have provided panel 4 of Johnson with an adhesive inhibitor adjacent to flaps 8, 8, and 9, as taught by either Wilbur or Schieman, because an adhesive inhibitor would have prevented unintentional sealing of flaps 8, 8, and 9 to the form. Id.

The examiner states that, with regard to claim 47, it would have been obvious to have used a pressure sensitive adhesive as taught by Schieman because it is deemed equivalent to Johnson's adhesive. Answer, page 6. Regarding claims 49, 53, 57, and 67, the examiner refers to Figure 7 of Johnson and states that it illustrates a detached section having all claimed features.

Appellant's position for this rejection is set forth on pages 21-24 of the appeal brief of Paper No. 22. Again, any referral to exhibits and attachments and affidavits not of record are not considered in this appeal (in connection with Amendment C, as explained, supra).

Beginning on page 21 of the brief, appellant argues that Schieman and Wilbur are structurally different products from the reply letter sheet of Johnson, and that it is inconceivable that an envelope would be combined with a reply letter sheet of Johnson. We are not convinced by such argument for the following reasons.

The determination that a reference is from a non-analogous art is two-fold. First, we decide if the reference is within the

field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986).

Following this test, one concerned with mail articles would be chargeable with knowledge found in each of Johnson, Wilbur, or Schieman, as each of these references is directed to such articles, and, as discussed, supra, a letter sheet does not exclude an envelope. Hence, we agree with the examiner that the applied references are analogous art and combinable. That is, each reference is within the field of the inventor's endeavor.

On page 22 of the brief, appellant discusses the product of Schieman and how it differs from the claimed invention. Appellant also argues how the product of Wilbur is different from the claimed invention. We again refer to our above-made comments regarding analogous art. We also note that one cannot show nonobviousness by attacking the references individually where the rejection is based on the combined teachings of the references. See, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Hence, we are not persuaded by argument attacking a reference individually, when the rejection involves a combination of references.

Furthermore, as discussed, supra, the examiner states that Johnson teaches the claimed invention except for the use of an adhesive inhibitor. Appellant does not dispute the teachings of Johnson as discussed by the examiner. The examiner then relies upon Wilbur and Schieman for teaching the use of an adhesive inhibitor to prevent adhesion at the location of the adhesive inhibitor. Office Action of Paper No. 12, page 6. The examiner explains that such an adhesive inhibitor would therefore have been obvious to use in the product of Johnson to inhibit adhesion at locations where desired (e.g., to prevent unintentional sealing of

flaps 8, 8, and 9). We note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the reference or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). We also note that the prior art can be modified or combined to reject claims as prima facie obvious as long as one of ordinary skill in the art would have had a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). Hence, we determine that the examiner has set forth a prima facie case of obviousness based upon his provided explanation as set forth in the rejection.

Near the bottom of page 22 of the brief, appellant also discusses the tear string arrangement of Johnson, and argues that, for practical reasons, the system of the present invention requires that the release layer is applied first, then the pressure sensitive adhesive. On page 23 of the brief, appellant states that the incorporation of Johnson's intrinsic tear string poses a serious problem because if the strings are applied before the pressure sensitive adhesive, they will disturb the coating of the latter. Appellant discusses other problems associated with the use of pressure sensitive adhesive, and concludes that therefore Johnson teaches away from its use. Brief, page 23.

In response, on page 9 of the supplemental examiner's answer, the examiner states that the arguments regarding commercially producing the letter sheets of Johnson are unpersuasive because the method of forming the device is not germane and the issue of patentability pertains to the device itself. We agree, as it is the claimed limitations that are at issue, and not the manner in which appellant makes his letter sheet.

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The examiner further states that appellant remarks that the incorporation of interactive release and pressure sensitive adhesives are not compatible with Johnson's invention is opinion. The examiner states that there is nothing in Johnson that precludes the incorporation of interactive release and pressure sensitive adhesives. We agree.

Beginning on page 24 of the brief, appellant argues the examiner's conclusion that it would have been obvious to provide panel 4 of Johnson with adhesive inhibitor adjacent to flaps 8, 8, and 9 as taught by either Wilbur or Schieman because the inhibitor would have provided unintentional sealing of the flaps 8, 8 and 9 to the form. Appellant states that there is no need whatsoever to use an adhesive inhibitor to interact with a layer of dry adhesive as the adhesive is not active that it does not need any inhibition. However, appellant overlooks the point that should one substitute the dry adhesive with another kind of adhesive, for example, a pressure sensitive adhesive, then one would want an adhesive inhibitor to prevent unwanted sealing. Schieman teaches such an adhesive system. As concluded by the examiner, interchanging a known type of adhesive with another known type of adhesive system would have been prima facie obvious.

In view of the above, we determine that the examiner has set forth a prima facie case of obviousness.

A prima facie case of obviousness is rebuttable by proof that the claimed invention possesses unexpectedly advantageous or superior properties. In re Papesch, 315 F.2d 381, 386-87, 137 USPQ 43, 47-48 (CCPA 1963). Objective indicia of unobviousness can be in the form of affidavits submitting evidence of secondary considerations, and must be considered by the examiner. See M.P.E.P. § 716.

On page 24 of the brief, appellant refers to Section II of Affidavit 1. The examiner comments on Affidavit 1 that was filed

with Amendment A on May 20, 2002 (Paper No. 6). The examiner states that this affidavit is insufficient. Supplemental Examiner's Answer, page 10.

Affidavit 1, section II, is set forth on pages 6-8 of Affidavit I. Beginning on page 6 of the affidavit, appellant explains how earlier references fail to anticipate the unexpected results and advantages of the claimed invention. Our comments on this rebuttal evidence (Affidavit 1, Section II) are set forth below.

As stated, supra, objective indicia of unobviousness can be in the form of affidavits submitting evidence of secondary considerations. See M.P.E.P. § 716. Such evidence of secondary considerations includes proof of commercial success of the claimed subject matter, a showing that the invention addresses a long-felt need, and proof of the failure of others to produce the invention. See M.P.E.P. § 716; In re GPAC Inc., 57 F.3d 1573, 1580, 35 USPQ2d 1116, 1121 (Fed.Cir. 1995). With regard to the issue of "failure of others", as stated supra, the M.P.E.P. requires that the examiner determine whether failure by others was merely attributable to a lack of interest, M.P.E.P. § 716, and a showing of long-felt need should convince the examiner that it was not. Other types of secondary considerations include copying and initial disbelief and/or acclaim by experts. In order to credit such objective evidence, the appellant must establish a nexus between the evidence and the merits of the invention. See GPAC, 57 F.3d at 1580, 35 USPQ2d at 1121 (Fed.Cir. 1995). Even when the required nexus is established, however, persuasive secondary considerations still may not outweigh a strong showing of obviousness based on the other Graham factors. See, e.g., Richardson-Vicks Inc. v. Upjohn Co., F.3d 1476, 44 USPQ2d 1181 (Fed. Cir. 1997). The weight of the legitimate inferences from the art of record are compared with

the weight of the rebuttal evidence to determine whether the rebuttal evidence overcomes the prima facie case. In re Lindell, 385 F. 2d 453, 455, 155 USPQ 521, 524 (CCPA 1967).

In the instant case, appellant has not established a nexus between the evidence and the merits of the invention. For example, while it is stated in Section II of Affidavit 1 that appellant's self sealing form is suitable for inkjet, laser, web, etc., printers, appellant does not claim such subject matter in any of the pending claims. Hence, no nexus has been established with appellant's claimed subject matter. Nor as appellant established that such uses would have been unexpected. We therefore determine that the affidavit evidence does not overcome the prima facie case of obviousness.

In view of the above, we affirm the 35 U.S.C. § 103 rejection of claims 45-47, 49-51, 53-55, 57, 58, 62-64, and 67 as being obvious over Johnson in view of Wilbur or Schieman.

V. The rejection of claims 48, 52, 56, and 65 under 35 U.S.C. § 103 as being obvious over Johnson, Wilbur, or Schieman, and further in view of Stenner

The examiner relies upon Stenner for teaching the aspect of appellant's claimed subject matter regarding wherein the self-sealing letter sheet is one of a continuous assembly of detachable self-sealing letter sheets. See page 6 of the Office Action of Paper No. 12, mailed September 11, 2002.

Appellant's position regarding this rejection is set forth on pages 25-40 of the brief. Appellant provides the same arguments with regard to the combination of Johnson in view of Wilbur or Schieman. Appellant additionally argues that Stenner is a multiple envelope with enclosures that disqualifies it as reference against a self-sealing letter sheet. Brief, page 25.

We emphasize that the examiner relies upon Stenner for teaching a plurality of forms in series, separated by lines and perforations. Office Action of Paper No 12, page 6. See, for example, Figures 8A and 8B of Stenner which depict continuous webs containing a plurality of sections for preparing an embodiment of the invention wherein the superposed webs move as a unit during processing. See column 5, lines 36-66 and column 6, lines 1-11 of Stenner. See also Figure 5 of Stenner. Also, Stenner involves mail articles, and thus, one skilled in the art of letter sheets would be charged with the knowledge set forth in Stenner. We are therefore unpersuaded by appellant's argument that Stenner is nonanalogous art.

Hence, we agree with the examiner's position as set forth in the paragraph bridging pages 10 and 11 of the supplemental examiner's answer, wherein the examiner states that appellant's discussion of the structure of Stenner does not obviate the teaching of Stenner to provide a plurality of forms in series, separated by perforation lines, in order to mass produce forms.

In view of the above, we therefore affirm the rejection of claims 48, 52, 56 and 65 under 35 U.S.C. § 103 as being obvious over Johnson in view of Wilbur or Schieman and further in view of Stenner.

VI. The rejection of claims 59 and 61 under 35 U.S.C. § 103 as being obvious over Johnson in view of Wilbur or Schieman

The examiner's position for this rejection is set forth on pages 6-7 of the Office Action of Paper No. 12. The examiner's position is that it would have been obvious to have modified Johnson's product such that one flap partially overlaps a first and second ply.

Appellant's arguments are set forth on pages 29-30 of the brief. Appellant presents the same arguments as presented, supra, with regard to the combination of Johnson in view of Wilbur or

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Schieman. Hence, for the reasons, discussed supra, we are not convinced by such arguments.

In view of the above, we therefore also affirm the 35 U.S.C. § 103 rejection of claims 59 and 61 as being obvious over Johnson in view of Wilbur or Schieman.

VII. Conclusion

The 35 U.S.C. § 112, first paragraph, rejection of claims 45-49 is affirmed.

The 35 U.S.C. § 112, first paragraph, rejection of claims 68-70 is reversed.⁵

The 35 U.S.C. § 102(b) rejection of claims 45-47, 62-64, and 66 as being anticipated by Schieman is affirmed.

The 35 U.S.C. § 103 rejection of claims 45-47, 49-51, 53-55, 57, 58 and 62-64, and 67 as being obvious over Johnson in view of Wilbur or Schieman is affirmed.

The rejection of claims 48, 52, 56, and 65 under 35 U.S.C. § 103 as being obvious over Johnson in view of Wilbur or Schieman and further in view of Stenner is affirmed.

The rejection of claims 59 and 61 under 35 U.S.C. §103 as being obvious over Johnson in view of Wilbur or Schieman is affirmed.

⁵ Upon return of this application to the jurisdiction of the examiner, consideration of any prior art rejection(s) of claims 68-70 is now necessary in view of the reversal of the §112, first paragraph, rejection, as it is possible that such a review was not conducted by the examiner because of the §112, first paragraph, rejection of claims 68-70.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sept. 13, 2003; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat., Office 21 (Sept. 7, 2004)).

AFFIRMED-IN-PART

Edward (Karl)

Edward C. Kimlin)
Administrative Patent Judge)

Beverly A. Lawkowski

Beverly A. Pawlikowski)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES


BAP/cam

Catherine Timm, Administrative Patent Judge , concurring

I concur with the decision of my colleagues. However, I wish to add a further explanation with regard to why the language "at least one mono-sectional body" is properly rejected. The problem with this language is that the specification never uses the terminology "mono-sectional" and it is not clear what would delineate a section in the self sealing form described in the specification. There are questions as to whether score lines or folding lines would delineate separate sections or whether different panels in the body delineate separate sections. Likewise, there is a question as to whether areas which are subsequently folded delineate separate sections. In light of these questions it cannot be said that there is written descriptive support for a "mono-sectional body" as claimed which is conformance with the requirements of 35 U.S.C. § 112, first paragraph. While it is true that the use of language that is different from that used in the specification is not in and of itself enough to show a lack of support for the underlying concept, here, the difference in language points to a broader problem, one that is at the apex of 35 U.S.C. § 112, paragraphs one and two. Here, the specification is not clear as to what is a "mono-sectional body" and there is no evidence that one of ordinary skill in the art would have an understanding as to what part of the structure that language refers. How can there be a description of the concept embodied by the language "mono-sectional body" when one cannot assign a concept thereto? Appellant would be better off claiming the structure using the descriptive terms of the specification rather than introducing a new term into the claims whose meaning is unclear.

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Concurring

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Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	

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APPENDIX

45. A self sealing letter sheet, so structured as to enable:

1) a private message and

2) a discretionary non-private message,
as the need for an envelope is eliminated,
said self sealing letter sheet comprising:

a) a blank of a sheet material, further comprising:

b) at least one mono-sectional flap,

c) at least one mono-sectional body,

d) at least one layer of adhesive, and at least one layer of adhesive inhibitor applied to said blank of a sheet material, in such a manner that when said at least one mono-sectional flap is in contact with said at least one mono-section body, said at least one layer of adhesive faces said at least one layer of adhesive inhibitor, whereby said at least one mono-sectional flap and said at least one mono-sectional body can be removably fastened to one another,

whereby said self sealing letter sheet is manufactured,

and whereby the user can input said private message and said discretionary non-private message, and subsequently fold and seal said self sealing letter sheet.

46. The self sealing letter sheet of claim 45), wherein said body further comprises at least one score line to aid the user to fold said body.

47. The self sealing letter sheet of claim 45), wherein said sheet material is paper, said adhesive is pressure sensitive adhesive, and said adhesive inhibitor is a release substance.

48. The self sealing letter sheet of claim 45), wherein said self sealing letter sheet is one of a continuous assembly of detachable self sealing letter sheets.

49. The self sealing letter sheet of claim 45) wherein said self sealing letter sheet further comprises means for detachment of a section of said self sealing letter sheet, and said section further comprises:

e) at least one mono-sectional flap,

f) at least one mono-sectional body,

g) at least one layer of adhesive, and at least one layer of adhesive inhibitor applied to said section, in such a manner that when said at least one mono-sectional flap is in contact with said at least one mono-sectional body, said at least one layer of adhesive faces said at least one layer of adhesive inhibitor, whereby said at least one mono-sectional flap and said at least one mono-sectional body can be removably fastened to one another,

whereby a detachable subordinate self sealing letter sheet is produced.

50. A self sealing letter sheet, comprising:

a) at least one flap,

b) a rectangular body,

c) at least one layer of an adhesive substance applied to said at least one flap,

d) at least one layer of an adhesive inhibitor substance applied to said rectangular body,

so when said at least one flap is placed in contact with said at least one body, said self sealing letter sheet is manufactured.

51. The self sealing letter sheet of claim 50), wherein said rectangular body further comprises at least one score line to aid the user to fold said rectangular body.

52. The self sealing letter sheet of claim 50), wherein said self sealing letter sheet is one of a continuous assembly of detachable self sealing letter sheets.

53. The self sealing letter sheet of claim 50) wherein said self sealing letter sheet further comprises means for detachment of a section of said rectangular body, and said section further comprises:

- e) at least one flap,
- f) a rectangular subordinate body,
- g) at least one layer of an adhesive substance applied to said at least one flap,

h) at least one layer of an adhesive inhibitor substance applied to said rectangular subordinate body,

so when said at least one flap is placed in contact with said rectangular subordinate body,

a detachable subordinate self sealing letter sheet is produced.

54. A self sealing letter sheet, folded so it comprises:

1) a first ply and

2) a second ply,

wherein said first ply is a body,

and said second ply is at least one flap, overlapping said first ply,

further comprising:

- a) at least one layer of adhesive on said second ply, and
- b) at least one layer of adhesive inhibitor on said first ply,

arranged so when said at least one layer of adhesive faces said at least one layer of adhesive inhibitor, said second ply is temporarily fastened to said first ply, whereby said self sealing letter sheet is produced.

55. The self sealing letter sheet of claim 54), wherein said body further comprises at least one score line to aid the user to fold said body.

56. The self sealing letter sheet of claim 54), wherein said self sealing letter sheet is one of a continuous assembly of detachable self sealing letter sheets.

57. The self sealing letter sheet of claim 54), wherein said self sealing letter sheet further comprises means for detachment of a section of said self sealing letter sheet, and said section is folded so it further comprises:

1a) a first ply and

2a) a second ply,

wherein said first ply is a body,

and said second ply is at least one flap, overlapping said first ply,

further comprising:

c) at least one layer of adhesive on said second ply,

d) and at least one layer of adhesive inhibitor on said first ply,

arranged so when said at least one layer of adhesive on said second ply faces said at least one layer of adhesive inhibitor on said first ply; said second ply is temporarily fastened to said first ply, whereby a detachable subordinate self sealing letter sheet is produced.

58. The self sealing letter sheet of claim 57), wherein said body further comprises at least one score line to aid the user to fold said body.

59. The self sealing letter sheet of claim 54), wherein said self sealing letter sheet further comprises a third ply, whereby said third ply is at least one flap partially overlapping said second ply and partially overlapping said first ply.

61. The self sealing letter sheet of claim 59), wherein said body further comprises at least one score line to aid the user to fold said body.

62. A self sealing form, comprising:

a) a sheet material cut into such a shape that a body and at least one flap are obtained,

b) at least one coating of a fastener and at least one coating of a fastener inhibitor, applied to said sheet material, in such a manner that when said at least one flap overlaps said body, said at least one layer of a fastener faces said at least one layer of a fastener inhibitor,

whereby said at least one flap fastens to said body in a temporarily fashion, and

whereby said self sealing form is manufactured, and is ready to be used.

63. The self sealing format of claim 62), wherein said sheet material is paper, said fastener is an adhesive substance and said fastener inhibitor is an adhesive inhibitor substance.

64. The self sealing form of claim 63), wherein said adhesive substance is a pressure sensitive adhesive substance, and said adhesive inhibitor substance is a release substance.

65. The self sealing form of claim 62), wherein said self sealing form is one of a continuous assembly of detachable forms.

66. The self sealing form of claim 62), wherein said body further comprises at least one score line to aid the user to fold said body.

67. The self sealing form of claim 62), wherein said self sealing form further comprises means for detachment of a section of said self sealing form, and said section further comprises:

c) a body and at least one flap,

d) at least one coating of a fastener and at least one coating of a fastener inhibitor, applied to said section of said self sealing form, in such a manner that when said at least one flap overlaps said body, said at least one layer of a fastener faces said at least one layer of a fastener inhibitor,

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whereby said at least one flap fastens to said body in a temporarily [sic] fashion,

whereby a detachable subordinate form is produced.

68. A self sealing letter sheet folded so it comprises:

- a) a body and
- b) at least one flap,

at least one layer of a repositionable adhesive and at least one layer of a dry adhesive, wherein said dry adhesive is susceptible to become active upon being moistened,

and wherein said at least one layer of a repositionable adhesive and said at least one layer of a dry adhesive are disposed so when said at least one flap and said body are in contact to one another, said repositionable adhesive and said dry adhesive avoid facing one another, and said at least one flap and said body are fastened to one another in a temporary fashion by the action of said repositionable adhesive,

whereby said self sealing letter sheet is produced and is now ready to be used.

69. The self sealing letter sheet of claim 68), wherein said self sealing letter sheet is one of a continuous assembly of detachable letter sheets.

70. The self sealing letter sheet of claim 68), wherein said body further comprises at least one score line to aid the user to fold said body.